

REMARKS

As an initial matter, Applicant would like to request for reconsideration the finality of the rejection of the last Office Action (Paper No. 16) as being premature, and to withdraw the finality of the last Office Action as allowed under MPEP § 706.07(d). Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement. MPEP § 706.07(a). In the Amendment filed May 3, 2004, Applicant amended claims 1, 6, 11, 13, 17, 19, 21 and 25. In issuing the last Office Action (Paper No. 16), the Office Action introduced a new reference USPN 6,249,782 (Day) to replace a previous reference USPN 6,650,761 (Rodrigues), in order to reject a feature of the claims that was not amended by the Amendment filed May 3, 2004. Therefore, the rejection based on Day introduces a new ground of rejection that is not necessitated by Applicant's Amendment filed May 3, 2004. Further, Applicant submitted an IDS on March 25, 2004, with 4 cited references and a copy of a PCT search report. The Day reference, however, was not part of the IDS submitted on March 25, 2004. Consequently, the rejection based on Day introduces a new ground of rejection that is not necessitated by Applicant's IDS filed March 25, 2004. Accordingly, Applicant respectfully requests withdrawal of the finality of the last Office Action as allowed under MPEP § 706.07(d).

Alternatively, Applicant respectfully requests entry and consideration of the above amendments even though presented after a final rejection. Applicant submits that

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the amendments do not raise new issues or require a new search. Further, entry and consideration of the amendments may isolate issues for potential allowance or appeal.

The amendments were not presented earlier in the prosecution due to a better understanding of the Examiner's position as reflected in the latest Office Action.

Claims 1-26 stand in this application. Claims 1, 6, 9, 11, 13, 17, 19, 21 and 25 have been amended. Reconsideration and allowance of the standing claims are respectfully requested.

Claims 1-2, 4-5, 9, 11-14, 16-23 and 25-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over USPN 6,442,548 (Balabine) in view of Day. Applicant respectfully traverses the rejection, and requests reconsideration and removal of the rejection.

Claims 1-2, 4-5, 9, 13-14, and 16-23 define over Balabine. Claims 1-2, 4-5, 9, 13-14, and 16-23 each include, either directly or indirectly, the feature of generating an identifier for a file name by a client, with the identifier to represent the file name and comprise a fewer number of bits than the file name, and sending the identifier and file name to a server. The Office Action states that Balabine:

[A] client software [for example, IXFS file system navigation tool 200] to receive a request from a user for a file having a file name, assigns a unique identifier via bits [e.g., the data object pointer (608), Fig. 6; Note: the pointer points to the data object identified by the file name, and the pointer is in bit format that is typically smaller than the number of bits of a file name] to the file name and send unique identifier and file name to a data server [for example, Informix® Universal Server.]

Office Action, Pages 2-3, Some Citations Omitted. Applicant submits that there may be a misunderstanding regarding how the Balabine system operates. The Balabine system includes a file system interface IXFS 300, which sits between a database unaware

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application 302 and a database 304. IXFS 300 converts a file request to an SQL query, and sends the SQL query to database 304. Database 304 returns the requested information to IXFS 300, which converts it to a file system object that includes data object pointer 608. The file system object is then returned to application 302. Balabine, Col. 5: Lines 23-66. As clearly indicated above, IXFS file system navigation tool 200 does not, under any circumstances, generate an identifier for a file name. Further, data object pointer 608 is not an identifier for a file name, but rather is a pointer to the location of the data object in the file system. Balabine, Col. 7: Lines 32-34. Moreover, IXFS 300 converts the requested information received from database 304 into a file system object after the requested information has been received from database 304. Consequently, assuming for the sake of argument that data object pointer 608 is an identifier as recited in the claimed subject matter, which applicant asserts is not the case, IXFS 300 does not create data object pointer 608 before sending the file request to the server as recited in the claimed subject matter.

Claims 1-2, 4-5, 9, 13-14, and 16-23 also define over Balabine in view of Day. As correctly noted in the Office Action, “Balabine did not specifically disclose that the unique identifier represents the file name with fewer bits than the file name.” Office Action, Page 3. The Office Action further states that this missing element is disclosed by Day, and therefore the combination of Balabine and Day disclose the claimed subject matter. Applicant respectfully disagrees since Balabine and Day both fail to disclose a client generating an identifier for a file name as recited in the claims. Consequently, even if Balabine and Day were combined they would still fail to disclose all the elements of the claims. As stated in the MPEP § 2142, a *prima facie* case of obviousness under 35

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U.S.C. § 103(a) requires, among other things, that the cited references, when combined, teach or suggest every element of the claims.

To further clarify the distinctions between the claimed subject matter and Day, the independent claims have been amended to recite language directed to a client generating an identifier for a file in response to a file request regardless of a length for the file name. By way of contrast, Day is directed to a file manager 106 which shortens an original file name that is too long for an API 104 to within a length constraint for API 104. Day, Col. 4: Lines 32-35. If the original file name is within the length constraint for API 104, then the original file name is returned and execution terminates. Day, Col. 4: Lines 41-44.

In addition, there is no motivation provided in Balabine or in Day to make the combination alleged in the Office Action. According to MPEP § 2142, without a motivation to combine the cited references, a rejection based on obviousness under § 103(a) is improper. Balabine fails to discuss identifier for a file name, let alone an identifier to represent the file name and comprise a fewer number of bits than the file name, as recited in the claimed subject matter. Therefore Balabine clearly fails to provide the proper motivation. Similarly, Day also fails to provide the proper motivation to combine. In fact, Day actually teaches away from combining Balabine and Day since Day is directed to solving a completely different problem than the claimed subject matter, that is, having file names fit a length constraint for an API rather than conserving bandwidth for an interconnect.

For at least the reasons given above, claims 1-2, 4-5, 9, 13-14, and 16-23 represent patentable subject matter over Balabine and Day, whether taken alone or in

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combination. Accordingly, removal of this rejection for claims 1-2, 4-5, 9, 13-14, and 16-23 is respectfully requested.

Claims 11, 12, 25 and 26 also define over Balabine in view of Day. Claims 11, 12, 25 and 26 each recite:

receiving a file request with a file name by a file system interface; generating an identifier for said file name by said file system interface in response to said first request regardless of a length for said file name, said unique identifier to represent said file name and comprise a fewer number of bits than said file name; and sending said unique identifier and file name to a file system manager.

As discussed previously, both Balabine and Day fail to disclose a file system interface generating an identifier for a file name, and sending the identifier and file name to a file system manager. Balabine does not generate an identifier at all, and only generates data object pointer 608 after receiving information from the file manager. Day only shortens a file name if the file name is not within a length constraint for an API. Consequently, the combination of Balabine and Day fail to disclose all the elements of claims 11, 12, 25 and 26. Accordingly, removal of this rejection is respectfully requested.

Claims 3, 6-8, 10 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Balabine in view of Day and further in view of USPN 5,619,690 (Matsumani). Further, claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Balabine in view of Day, Matsumani and Applicant Admitted Prior Art (AAPA). Applicant respectfully traverses these rejections, and requests reconsideration and withdrawal of these rejections.

Claims 3, 6-8, 10, 15 and 24 define over Balabine, Day, Matsumani and AAPA. Claims 3, 6-8, 10, 15 and 24 each recite the same elements as discussed with reference to

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Balabine and Day. The missing elements are not disclosed by Matsumani and AAPA. Therefore, the combination of Balabine, Day, Matsumani and AAPA still fails to disclose all the elements of claims 3, 6-8, 10, 15 and 24. Applicant respectfully requests withdrawal of these rejections.

For at least the above reasons, Applicant submits that claims 1-26 recite novel features not shown by the cited documents. Further, Applicant submits that the above-recited novel features provide new and unexpected results not recognized by the cited documents. Accordingly, Applicant submits that the claims are not anticipated nor rendered obvious in view of the cited documents.

Applicant does not otherwise concede, however, the correctness of the Office's rejection with respect to any of the dependent claims discussed above. Accordingly, Applicant hereby reserves the right to make additional arguments as may be necessary to further distinguish the dependent claims from the cited references, taken alone or in combination, based on additional features contained in the dependent claims that were not discussed above. A detailed discussion of these differences is believed to be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

It is believed that claims 1-26 are in allowable form. Accordingly, a timely Notice of Allowance to this effect is earnestly solicited.

The Examiner is invited to contact the undersigned at 724-933-3387 to discuss any matter concerning this application.

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The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 02-2666.

Respectfully submitted,

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Under 37 CFR 1.34(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to:
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Deborah Higham — 10-12-04
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